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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Anja KNUPPEL et al.

Confirmation No. 1726

Group Art Unit: 1617

Serial No. : 10/017,157

Examiner: Kantamneni, Shobha

Filed : December 14, 2001

For : USE OF POLYURETHANES FOR IMPROVING THE WATER
RESISTANCE OF COSMETIC AND DERMATOLOGICAL
FORMULATIONS

ELECTION WITH TRAVERSE

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is in response to the requirement for restriction under 35 U.S.C. § 121 mailed from the U.S. Patent and Trademark Office on July 5, 2006, which set a one-month shortened statutory period for reply to expire on August 7, 2006 (August 5/6, 2006 being a Saturday/Sunday). Applicants hereby request an extension of time for one month and are concurrently filing a formal Request for Extension of Time, together with all requisite fees therefor. If for any reason the Request for Extension of Time is not associated with the file, or the fee submitted herewith is deemed insufficient for any reason, the present submission should be interpreted to include the requisite Request for Extension of Time, and the Patent and Trademark Office is hereby authorized to charge any fees necessary to preserve the pendency of this application to Deposit Account No. 19-0089.

RESTRICTION REQUIREMENT

The Examiner has required restriction to one of the following inventions:

I. Claims 19-21 (in part), 22-24 and 28-40 (in part), drawn to a method of protecting skin from the damaging effects of exposure to UV light, said method comprising (1) topically applying to skin an effective amount of a cosmetic oil-in-water formulation comprising (i) at least one UV filter substance and (ii) at least one of a water-soluble or water-dispersible anionic polyurethane and a salt thereof; and (2) forming a moisture-resistant layer on said skin, classified in class 514, subclass 553, 622, 772.3; class 424, subclass 59.

II. Claims 19-21 (in part), 25-27 and 28-40 (in part), drawn to a method of protecting skin from the damaging effects of exposure to UV light, said method comprising (1) topically applying to skin an effective amount of a cosmetic oil-in-water formulation comprising (i) at least one UV filter substance and (ii) at least one of a water-soluble or water-dispersible cationic polyurethane, a cationic polyurea and a salt thereof; and (2) forming a moisture-resistant layer on said skin, classified in class 514, subclass 642, 772.3; class 424, subclass 59.

III. Claims 41-43 (in part), 44-46 and 50-63 (in part), drawn to a method of improving the water resistance of a cosmetic formulation which contains at least one UV filter substance, wherein the formulation comprises at least one of a film-forming, water-soluble or water-dispersible anionic polyurethane and a salt thereof, classified in class 514, subclass 553, 772.3; class 424, subclass 401.

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IV. Claims 41-43 (in part), 47-49 and 50-63 (in part), drawn to a method of improving the water resistance of a cosmetic formulation which contains at least one UV filter substance, wherein the formulation comprises at least one of a film-forming water-soluble or water-dispersible cationic polyurethane, a cationic polyurea and a salt thereof, classified in class 514, subclass 588, 642, 772.3; class 424, subclass 401.

V. Claim 64, drawn to a method of improving the water resistance of an O/W formulation, wherein the method comprises incorporating at least one film forming water-soluble or water-dispersible polyurethane, classified in class 514, subclass 772.3, 938; class 424, subclass.

ELECTION

In order to be responsive to the requirement for restriction, Applicants elect, with traverse the invention set forth in **claim 64** (invention V as identified in the Restriction Requirement).

TRAVERSE

Applicants respectfully submit that a restriction requirement is inappropriate in this case. Even if one were to assume, *arguendo*, that the inventions of Groups I to V are distinct, the requirement for restriction should be withdrawn, because there is no serious burden.

In MPEP Chapter 800, the Office sets forth its policy by which examiners are guided in requiring restriction under 35 U.S.C. § 121. Section 803 states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner

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must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants note that all of the five inventions identified in the Restriction Requirement relate generally to the use of water-soluble or water-dispersible polyurethanes for improving the water-resistance of an O/W formulation.

Applicants have elected claim 64, i.e., a claim drawn to a method of improving the water resistance of an O/W formulation by incorporating in the O/W formulation at least one film-forming, water-soluble or water-dispersible polyurethane.

Under these circumstances it is not seen that it would be justifiable to exclude from a corresponding search O/W formulations which are used for protecting skin from the damaging effects of UV light and comprise at least one UV filter substance and an anionic or cationic polyurethane as film-forming, water-soluble or water-dispersible polyurethane. If corresponding subject matter must not be excluded from the search, then the search for claim 64 necessarily encompasses a substantial portion, if not all, of the subject matter of claims 19-63. Accordingly, there is no serious burden on the Examiner if all of claims 19-64 are searched and examined.

For the above reasons alone, the Restriction Requirement should be withdrawn, which action is respectfully requested.

Applicants point out that should the present Restriction Requirement be made final, Applicants will submit claims which depend from (or are similar to) claim 64 and correspond to present claims 19-63. Submitting these claims now, without cancelling

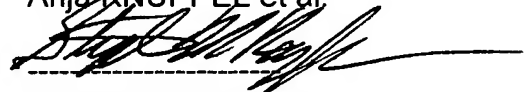
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claims 19-63, would apparently require the payment of considerable excess claims fees (in addition to those already paid).

Should the Examiner, despite the observations set forth above, intend to make the present Restriction Requirement final, it would be highly appreciated if Applicants were given the opportunity to submit additional claims which depend from (and/or are similar to) claim 64 before a first action on the merits is issued. Accordingly, should the Examiner intend to make the Restriction Requirement final, the Examiner is respectfully asked to contact the undersigned by telephone, whereupon a corresponding Amendment would be filed without delay.

Should there be any questions, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
Anja KNUPPEL et al.



Neil F. Greenblum
Reg. No. 28,394

August 28, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Stephen M. Roylance
Reg. No. 31,296